

REMARKS

This responds to the Office Action dated February 9, 2007.

No claims are amended, canceled or added as a result, claims 1, 3-16, 18-22 and 24-26 remain pending in this application.

§102 Rejection of the Claims

Claims 1, 4, 16 and 19-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bush (U.S. Patent No. 5,755,762). The Applicant respectfully traverses the rejection and requests the Office to consider the following.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), M.P.E.P. §2131, 8th Ed., Rev. 4).

The Office admits that Bush does not teach or suggest expanded ultra-high molecular weight polyethylene. With respect to anticipation rejections, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

In the **Response to Arguments** section, the Examiner insists that the mere mention by Bush of polyethylene is sufficient, where Bush teaches the structure is chosen to reduce fibrous tissue ingrowth. Applicant respectfully asserts this teaching by Bush is not sufficient to anticipate what is claimed. Key differences include the admission by the Office that Bush implicitly does not teach eUHMWPE. Another key difference is that Bush suggests his covering “reduce fibrous ingrowth” (Bush at column 6, line 14), and Applicant expressly teaches “eUHMWPE can have an expanded matrix that nevertheless repels fibrotic tissue ingrowth”.

Further, from Bush, it simply is not clear what Bush is teaching beyond the mere mention of a polyethylene. Further as to the preferred embodiments taught by Bush, her focus is on fluoropolymers. (Column 6, lines 6,7). By admission of the Office, Bush does not teach expanded ultra-high molecular weight polyethylene. Withdrawal of the rejection is respectfully requested.

Further to the Applicant's teaching of what is an eUHMWPE, molecular weights are taught as definitions, within the body of Applicant's disclosure, such that a known molecular weight is implicit in the claimed eUHMWPE. Bush is entirely devoid of teaching any molecular weights to provide the interested public with sufficient knowledge as to what is her incidental teaching to use polyethylene. Because “[t]he identical invention must be shown in as complete detail as is contained in the ... claim”, *Richardson*, and because Bush is entirely silent on eUHMWPE, Bush does not anticipate the claims. Withdrawal of the rejection is respectfully requested.

§103 Rejection of the Claims

Claims 1, 3-14, 16 and 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukup et al. (U.S. Patent No. 6,704,604) in view of Bush (U.S. Patent No. 5,755,762). Applicant respectfully traverses the rejection and requests the Office to consider the following.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (M.P.E.P. § 2143 8th Ed, Rev.4).

The Office Action admits in this rejection, that both Soukup and Bush fail to teach eUHMWPE. Because all the claim limitations are not taught in the cited references, withdrawal of the rejections is respectfully requested.

The Office asserts at page 5, that the Applicant should disclose the use of eUHMWPE as opposed to the other porous materials. But the Office again uses deficient language from either Bush or Soukup (Applicant cannot tell), that the cited references teaches “fibrous ingrowth is reduced, whereas Applicant teaches fibrous ingrowth is repelled. Further, the Office cited to page 10, for example, of Applicant’s disclosure. But the Office will note that the various materials are taught separately, but claimed (previously) in claim 2. This is neither an admission of equivalency nor of an “obvious matter of design choice” (Office Action at page 5).

Withdrawal of the rejections is respectfully requested.

Claims 15, 22 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukup et al. (U.S. Patent No. 6,704,604) in view of Bush (U.S. Patent No. 5,755,762) as applied above, and further in view of Czura et al. (U.S. Patent No. 5,562,715). Applicant respectfully traverses the rejection and requests the Office to consider the following.

The Office Action admits that “Soukup … fails to teach that the porous covering may include ‘expanded ultra-high molecular weight polyethylene.’ ” (Office Action at page 4). Further as set forth above, by admission of the Office, Bush also does not teach expanded ultra-high molecular weight polyethylene. The Office Action also admits that “Soukup … fails to disclose a dielectric coating over the metallic can, and a passageway through the dielectric coating to form an exposed portion of the container. Consequently by this admission, Soukup fails to teach at least two claim limitations. The Office turns to Czura to remedy the deficiencies of Bush and Soukup. But Czura also fails to teach an expanded ultra high molecular weight polyethylene. Because all the claim limitations are not taught in the cited references, withdrawal of the rejection is respectfully requested.

The Office also asserts that “Applicant has not disclosed that the use of ‘expanded ultra high molecular weight polyethylene’ as opposed to the other porous materials of original claim 2 solves any stated problem etc.” Applicant respectfully disagrees. The Office cited to page 10,

for example, of Applicant's disclosure. But the Office will note that the various materials are taught separately, but claimed (previously) in claim 2. This is neither an admission of equivalency nor of an "obvious matter of design choice" (Office Action at page 5). Consequently the assertion by the Office, regarding any distinction taught or implied for expanded ultra high molecular weight polyethylene over other materials found in canceled claim 2, is without foundation. Withdrawal of the rejection is respectfully requested.

RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/662,129

Filing Date: September 12, 2003

Title: EXPANDED ULTRA-HIGH MOLECULAR WEIGHT POLYETHYLENE IN AN ELECTRICAL MEDICAL DEVICE

Page 11

Dkt: 279.445US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6912 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DANIEL J. COOKE ET AL.

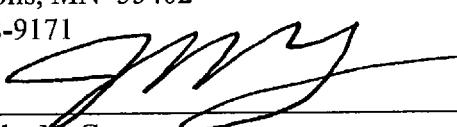
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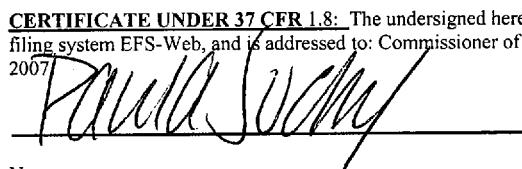
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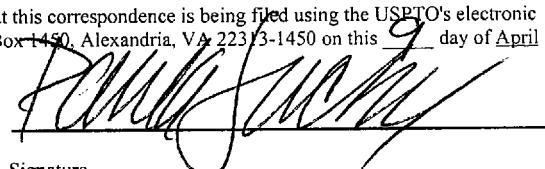
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9 day of April 2007.


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